

REMARKS

The Official Action mailed December 1, 2005, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on February 17, 2005; and July 26, 2005. The Applicants note the partial consideration of the Information Disclosure Statement filed on November 4, 2004 (received by OIPE November 5, 2004). Specifically, it appears that the Examiner inadvertently overlooked the citation of the "European Search Report dated September 3, 2004 for EP 04 00 4257," which is cited in the "OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS" section of the Form PTO-1449. In order to facilitate the Examiner's consideration of the European Search Report, the Applicants have attached a courtesy copy of the partially considered Form PTO-1449. The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the European Search Report.

Further, the Applicants have not received acknowledgment of the Information Disclosure Statement filed on November 2, 2005 (received by OIPE November 4, 2005). The above-referenced Information Disclosure Statement appears in the Image File Wrapper, and consideration of this Information Disclosure Statement is respectfully requested.

Claims 7-17 were pending in the present application prior to the above amendment. Dependent claims 9 and 14 have been canceled without prejudice or disclaimer, claims 7, 8, 10, 12, 13 and 15 have been amended to better recite the features of the present invention, and new claims 18-21 have been added to recite additional protection to which the Applicants are entitled. Accordingly, claims 7, 8, 10-13 and 15-21 are now pending in the present application, of which claims 7, 8, 12, 13,

18 and 19 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 7-17 as anticipated by U.S. Patent No. 5,304,357 to Sato et al., and claims 7-9 and 12-14 as anticipated by U.S. Patent No. 6,423,585 to Yamazaki et al. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 7, 8, 12 and 13 have been amended to recite that a first laser beam is a harmonic wave of a solid laser and a second laser beam has a fundamental wave emitted from a solid laser. The usefulness of a fundamental wave is described and supported in the specification, for example, in Embodiment Mode 1, particularly paragraph [0044]. The Applicants respectfully submit that Sato or Yamazaki '585 does not teach the above-referenced features of the present invention, either explicitly or inherently.

Also, the independent claims recite irradiating a surface with first and second laser beams. Yamazaki '585 does not teach that the same side of a surface is irradiated by first and second laser beams. Rather, Yamazaki '585 appears to teach that "ultraviolet light is preferably irradiated from an upper face side of a film to be treated since the light is apt to be absorbed by a glass substrate" (column 6, lines 36-38) and "infrared light can be irradiated from a lower face side of the film to be treated since it is difficult to be absorbed by a glass substrate" (column 6, lines 44-46). For example, Figure 1B of Yamazaki '585 (reproduced below) shows this relationship.

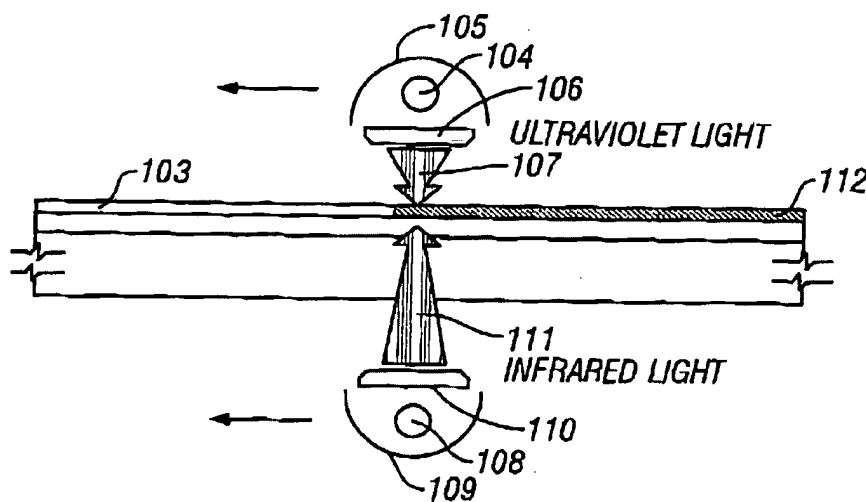
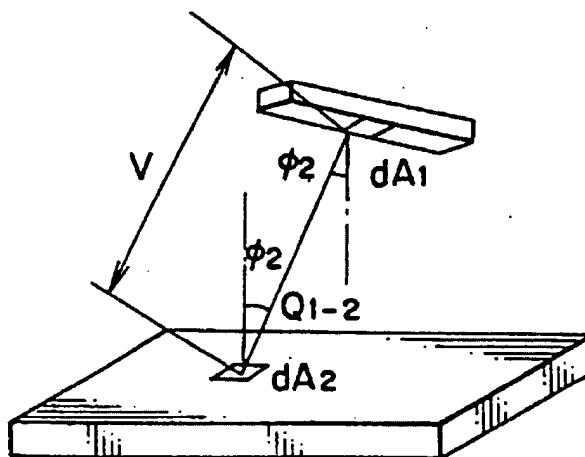


FIG. 1B

That is, in Yamazaki '585, different sides of a film are irradiated. Therefore, Yamazaki '585 does not teach irradiating a surface with first and second laser beams, either explicitly or inherently.

Further, regarding dependent claims 11 and 17, the Official Action asserts that Figures 17 and 20 of Sato teach "wherein an incidence angle Φ of the first laser beam to the surface to be irradiated satisfies an inequality $\Phi \geq \arctan (W/2d)$, when a major axis of the elongated beam or a minor axis of the elongated beam is assumed to have a length of W " (pages 3 and 5, Paper No. 20051107). Specifically, it appears that Figure 20 of Sato (reproduced below) is relied upon to support the assertion.

Fig. 20



However, the claimed relation of $\Phi \geq \arctan (W/2d)$ includes a thickness (d) of a substrate. However, Figure 20 of Sato does not include a relationship between an angle and an attribute of a substrate, much less a thickness of a substrate. Therefore, Sato does not teach an inequality $\Phi \geq \arctan (W/2d)$, either explicitly or inherently. The Official Action concedes that Yamazaki '585 does not teach the above-referenced features (page 8, *Id.*).

Since Sato or Yamazaki '585 does not teach all the elements of the claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action apparently rejects claims "****" as obvious based on the combination of Yamazaki '585 and Sato. Based on pages 7-9 of the Official Action, it appears the Official Action rejects dependent claims 10, 11 and 15-17 based on Yamazaki '585 and Sato. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

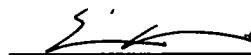
Please incorporate the arguments above with respect to the deficiencies in Sato and Yamazaki '585 individually. The combination of Sato and Yamazaki '585 does not cure the deficiencies in the references individually. With respect to the independent claims, Sato and Yamazaki '585, either alone or in combination, do not teach or suggest that a first laser beam is a harmonic wave of a solid laser and a second laser beam has a fundamental wave emitted from a solid laser. Also, with respect to dependent claims 11 and 17, Sato and Yamazaki '585 do not teach or suggest that an incidence angle Φ of a first laser beam to a surface to be irradiated satisfies an inequality $\Phi \geq \arctan(W/2d)$, when a major axis of an elongated beam or a minor axis of the elongated beam is assumed to have a length of W. Since Sato and Yamazaki '585 do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be

maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New claims 18-21 have been added to recite additional protection to which the Applicants are entitled. For the reasons stated above, the Applicants respectfully submit that new claims 18-21 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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